

REMARKS

Informalities

The Examiner requested correction of certain informalities. Applicant believes that these are non-narrowing informalities and has made the corrections but reserves the right to use and rely on the original specification, if necessary.

Claim Status

Claims 1-16 are pending in the Application. The Examiner has rejected claims 1-12, 15, and 16. The Examiner has objected to claims 13 and 14.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected the applicant's claims under 35 U.S.C. §102(b) which states, "A person shall be entitled to a patent unless. . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States." For a claim to be rejected under this statute, it must be anticipated by the prior art. Anticipation occurs when every element of the claimed invention is met. See, Carella v. Starlight Archery & Pro Line Co., 804 F.2d 135 (Fed. Cir. 1986) (stating, "[a]nticipation under Section 102 requires 'the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim'"); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675 (1988 Fed. Cir.) (stating, "[f]or a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference"); Helifix Ltd. V. Blok-Lok Ltd., 208 F.3d 1339 (Fed. Cir. 2000) (stating, "[t]o be anticipating, a prior art reference must disclose 'each and every limitation of the claimed invention[,] . . . must be enabling[,] and must describe . . . [the] claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention'"). In this case, not every element of the applicant's claimed invention is met in the prior art.

Gunn, U.S. Patent No. 4,544,195

The Examiner rejected claim 1 under 35 U.S.C. §102(b) based upon U.S. Patent No.

4,544,195 issued to Gunn ("Gunn '195"). The Examiner's office action stated that Gunn '195 teaches the applicant's claimed apparatus. The applicant respectfully disagrees with the Examiner's position.

The applicant's window system comprises a flexible window (10), a soft-cover window frame (20), and an insertable screen (30). Additionally, the insertable screen (30) is matingly coupled to the window perimeter of the flexible window (10). Further, the applicant's claimed apparatus allows the user of a vehicle with a soft-covering system to open or remove the flexible, convertible windows, but not have the nuisance of the wind blowing directly on the passengers, not leave the passenger area open to passersby, and protect the interior of the vehicle from the weather elements. In order to achieve these desired characteristics, the insertable screen (30) of the window system remains in place when the flexible window (10) is down. This window system can be used on vehicles, such as Jeeps or convertibles, that are driven without windows in place.

In Gunn '195, the disclosed window opening, screen, and window pane is not similar to that of the applicant's. The rear covering in Gunn '195 is meant to be a cover on the back of a pick-up truck that has a tailgate tiltable from an upright closed position downwardly to a horizontal open position and **requires a rigid camper enclosure** mounted over the bed of the pick-up truck (Gunn '195 Claim 1). The window pane in Gunn '195 is part of the rear cover of a pick-up truck. The screen in Gunn '195 is not insertable into a convertible soft covering system like in the applicant's invention. Moreover, the screen in Gunn '195 is not detachable (Gunn '195 Column 1, lines 63-68). Additionally, the soft cover window frames in Gunn '195 are cloth borders cut into the rear covering rather than actual frames as in applicant's invention.

Moreover, in Gunn '195 the screen is an insect screen that is sewn to the cloth borders (column 2, lines 62-64). This screen does not keep the wind off of passengers while the vehicle is moving nor does it protect the interior of the vehicle from the damaging effects of the sun as in applicant's invention. Further, the insect screen in Gunn '195 must be attached to the cloth border on all sides by sewing in order to achieve the desired result of keeping insects out. In contrast, the applicant's insertable screen (30) does not have to be matingly coupled on all sides (Detailed Description p. 9, lines 7-14).

As discussed above, every element of applicant's claim 1 is not present in Gunn '195.

Gunn -
at least partially
detachable
definition of
frame
→ detachable not claimed
"insertable" claimed

which meets
limitation
of
"for use on
a vehicle
w/ a convertible
soft-covering
system"
camper part
is soft, covers
the tailgate &
is convertible

not
claimed

Therefore, applicant respectfully disagrees with the Examiner's 35 U.S.C. §102 rejection.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected Applicant's claims under 35 U.S.C. §103(a).

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. §103(a).

The Examiner rejected claims 2-12 and 15-16 under 35 U.S.C. § 103(a) as obvious. The Examiner claimed that the applicant would have been motivated to combine the cited inventions disclosed in these patents to create applicant's window system for convertible motor vehicles. The Applicant respectfully disagrees with Examiner's position.

A. Prima Facie Case of Obviousness

The Examiner has failed to establish a prima facie case of obviousness. When examining a patent application, the Examiner has the initial burden of factually supporting a prima facie conclusion of obviousness. MPEP §2142. If the Examiner fails to put forth a prima facie case of obviousness, applicant has no obligation to come forward with evidence of non-obviousness. Id. For the Examiner to establish a prima facie case of obviousness, three criteria must be met. Id. First, there must be a suggestion or motivation to modify or combine the prior art references. Id. Second, there must be a reasonable expectation of success. Id. Third, the prior art reference must teach or suggest all the claim limitations. Id.

For the Examiner to satisfy the first criterion, the cited references must "expressly or impliedly suggest the claimed invention." Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). Or, in the alternative, the Examiner must establish a convincing line of reasoning as to why [one skilled in the art] would have found the claimed invention to have been obvious in light of the teachings of the references. Ex parte Clapp, at 973. Additionally, when the incentive to combine the teachings of the references is not readily

apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper. Ex parte Skinner, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986).

There are three sources to look for a motivation to combine prior art references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). However, the Examiner cannot rely on the level of skill in the art to provide the suggestion to combine the prior art references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 1324 (Fed. Cir. 1999). Further, the fact that the prior art references *can* be combined is not enough to establish prima facie obviousness without a suggestion in the prior art to combine the references. In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1990). Moreover, if the modification of the prior art would render it inoperable for its intended purpose, there is no suggestion or motivation to make the modification. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984). Finally, if the modification of the prior art reference would change the principle of operation of the modified prior art reference, then the prior art reference is not sufficient to establish prima facie obviousness. In re Ratti, 270 F.2d 810, 813 (CCPA 1959).

Applicant kindly suggests that, the Examiner has not satisfied the first criterion to establish prima facie obviousness. U.S. Patent No. 4,544,195 issued to Gunn (Gunn '195) and U.S. Patent No. 5,921,571 issued to Bell (Bell '571) are not analogous prior art references and do not expressly or impliedly suggest Applicant's invention. Gunn '195 teaches a cover that is used on the back of pick-up trucks with rigid campers attached. The cover is not used on a vehicle with removable, flexible windows as in applicant's invention. Similarly, Bell '571 provides no express or implied suggestion to create applicant's invention. Bell '571 describes a folding frame for use as a trailer. In fact, Bell '571 requires a folding frame and a body made of pliant or flexible fabric (Bell '571 Column 6, lines 15-21). This teaches away from the requirement of a "rigid camper enclosure" in Gunn '195 (Gunn '195 Column 1, line 43). The trailer is not analogous art and is in no way connected to the window system created by applicant.

Since there are no express or implied suggestions to create the claimed invention in the prior art, the Examiner must provide a convincing line of reasoning why Gunn '195 and Bell '571 would be obvious to one skilled in the art. In this case, the Examiner has not shown a suggestion in the prior art to combine the two references. In support of the

nature of
problem to
be solved was
mounting a
window in
a flexible
cover -
both address
mounting window
in flexible cover

conclusion of obviousness of claim 2, the Examiner states that Gunn '195 discloses a screen that is sewn to the frame and that the window and screen are coupled using a zipper. (Examiner's Office Action p. 3). Additionally, the Examiner indicates that Bell '571 teaches that zippers and hook and loop type fasteners are equivalent. (Examiner's Office Action p. 4). The Examiner then concludes that "it would have been obvious to one of ordinary skill in the art to use hook and loop type fasteners to couple the screen with the frame and the flexible window." The Examiner further explains that one skilled in the ordinary art would be motivated to combine Gunn '195 and Bell '571 to "make repairing or replacing [the screen] easier." This line of reasoning does not show a suggestion in the prior art to combine a covering for a pick-up truck with a foldable trailer to create the applicant's window system. Additionally, combining a rear cover for a pick-up truck with a foldable trailer would render both inventions inoperable. Therefore, applicant kindly notes that the Examiner has failed to make a prima facie case of obviousness.

The second criterion requires a reasonable expectation of success when combining the prior art references. If there is a reasonable expectation of success, prima facie obviousness is established. In re Merck & Co., 800 F.2d 1091, 1096 (Fed. Cir. 1986). There is not a requirement of absolute predictability, but some predictability is required. MPEP §2143.02. A conclusion of non-obviousness can be established if there is evidence showing there is *no* reasonable expectation of success. In re Rinehart, 531 F.2d 1048, 1054 (CCPA 1976). Further, the predictability of success is determined at the time the invention was made. Ex parte Erlich, 3 U.S.P.Q.2d 1011, 1016 (Bd. Pat. App. & Inter. 1986).

In the present case, there is no reasonable expectation of success when combining Gunn '195 and Bell '571. Gunn '195 and Bell '571 teach inventions that are distinguishable from each other. Gunn '195 describes a cover for a pick-up truck that provides no suggestion that it could be used as a window system for convertible vehicles, while Bell '571 merely describes a foldable trailer. A cover for a pick-up truck and a foldable trailer are not combinable to create a successful window system for convertible vehicles. In fact, Bell '571 requires a folding frame and a body made of pliant or flexible fabric (Bell '571 Column 6, lines 15-21). This teaches away from the requirement of a "rigid camper enclosure" in Gunn '195 (Gunn '195 Column 1, line 43). The Examiner has not proved a prima facie case of

obviousness because there is no evidence to demonstrate a reasonable expectation of success.

The third criterion to establish prima facie obviousness requires that all claim limitations be taught or suggested by the prior art. In re Royka, 490 F.2d 981 (CCPA 1974). Further, when judging the patentability of the Applicant's claim, all of the words in the claim must be considered. In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970). Additionally, if an independent claim is non-obvious, then claims depending from it are also non-obvious. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988).

In this case, not all the claim limitations are taught or suggested by the prior art. Neither Gunn '195 nor Bell '571 teach the amount of sunlight that will be blocked or that the screen(s) reduce noise and air. Because not all the claim limitations are taught or suggested by the prior art, the Examiner has not satisfied the third criterion. Hence, there is no prima facie case of obviousness.

B. Prior Art "As A Whole" Does Not Show Obviousness

Even if the Examiner established a prima facie case of obviousness, the prior art references do not render Applicant's invention obvious under 35 U.S.C. §103(a). When establishing obviousness, the prior art reference must be considered as a whole, there must be a motivation or suggestion to combine the prior art references, and the prior art reference must be analogous to Applicant's field of endeavor or reasonably pertinent to the problem Applicant faced. In re Antonie, 559 F.2d 618, 620 (C.C.P.A. 1977) (requiring that prior art reference must be considered as a whole). In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (stating there must be evidence in the prior art that is relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness). In re Oetiker, 977 F.2d 1443, 1446 (Fed. Cir. 1992) (requiring the reference either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned).

1. Rejection of Claim 2

The Examiner rejected claim 2 as being unpatentable over Gunn '195 in view of Bell '571. The Examiner claimed that it would have been obvious to create applicant's invention

from Gunn '195 and Bell '571. Applicant respectfully disagrees with the Examiner's rejection regarding claim 2.

Gunn '195 and Bell '571 are non-analogous prior art and cannot be combined. Neither Gunn '195 nor Bell '571 disclose or describe a window system for use on convertible vehicles. Rather, Gunn '195 and Bell '571 disclose a rear cover for a pick-up truck and a foldable trailer, respectively. The structures and functions of the inventions disclosed in Gunn '195 and Bell '571 are different than the structure and function of applicant's invention. An important functional feature of Gunn '195 is its ability to attach to the back of a pick-up truck. Gunn '195 provides "a cover for a conventional rigid camper enclosure mounted over a bed of a conventional pickup truck. . . ." (Gunn '195 Column 1, lines 42-44). Applicant's invention does not function as a rear cover for a pick-up truck. Instead, Applicant's invention is used on a convertible vehicle as window coverings to protect the passengers and interior of the vehicle.

In addition, Bell '571 is structurally and functionally different than applicant's invention. Bell '571 consists of a foldable frame and body that provides a chassis for a vehicle or trailer. (Bell '571 Abstract). This is different than applicant's invention which, as stated above, is a window system for a convertible vehicle.

Even assuming arguendo that Gunn '195 and Bell '571 are analogous art, there is no suggestion or motivation to combine Gunn '195 and Bell '571 to create a window system for convertible vehicles. Applicant directs Examiner to Gunn '195 which states that the invention "relates generally to a flexible cover attachable to the rear end of a conventional, rigid camper enclosure of the type adapted to mount over the bed of a conventional pickup truck." (Gunn '195 Column 1, lines 6-9). Bell '571 discloses a "foldable frame for a covered trailer or moving vehicle. . . ." (Bell '571 Column 1 lines 6-7). The stated purposes of Gunn '195 and Bell '571 do not suggest to one skilled in the art the combination to create a window system for use on convertible vehicles. The Applicant's invention specifically states that the invention is "a window system for use on a motor vehicle with a convertible soft-covering system." (Applicant's Disclosure p. 4 lines 22-23).

Further, the rear cover for a pick-up truck disclosed in Gunn '195 does not possess the required features to function properly as a window system for use on convertible vehicles. A rear cover for a pick-up truck could not be used in a way similar to applicant's

invention and be expected to protect passengers or the interior of a vehicle when the vehicle is moving. Moreover, Gunn '195 does not disclose a material that can block the amount of sunlight that applicant's invention blocks.

Additionally, Gunn '195 discloses the screen being matingly coupled on all four sides. Specifically, Gunn '195 discloses the screen attached to the surface of the sheet around the pane as opposed to the partially detachable window pane (Gunn '195 Column 1, line 63-65). Applicant's invention does not require the insertable screen to be matingly coupled on all sides so that it can properly function. Further, applicant's insertable screen could be removed. In Gunn, '195 the pick-up truck cover is specifically made for use as a cover to extend the use of the pick-up truck bed. (Gunn '195 Column 1 lines 44-47). In contrast, applicant's window system is specifically designed for use in a convertible vehicle.

Gunn '195 and Bell '571 are non-analogous prior art references. Moreover, claim 2 depends from an independent claim that is not obvious meaning that claim 2 is also non-obvious as discussed above. Also, there is no motivation or suggestion to combine the two to create applicant's invention. Finally, combining Gunn '195 and Bell'571 would destroy their intended function. Thus, when viewed as a whole, neither of the prior art inventions renders applicant's invention obvious, and they cannot be combined since it would destroy their function.

2. Rejection of Claims 6, 11, 12, and 15

The Examiner rejected claims 6, 11, 12, and 15 as being unpatentable over Gunn '195. The Examiner claimed that Gunn '195 "discloses the window system of claim 1." (Examiner's Office Action p. 4). Additionally, the Examiner indicated that "[i]t would have been obvious to one of ordinary [skill in the art to] use two screens instead of one since it has been held that a mere duplication of parts involves only routine skill in the art." (Examiner's Office Action p. 4). Applicant respectfully disagrees with the Examiner's rejection regarding claims 6, 11, 12, and 15.

Gunn '195 is a non-analogous prior art reference, and, as discussed above, does not disclose every element of applicant's claimed invention. In fact, Gunn '195 teaches away from applicant's invention because it teaches the use of a rigid camper and not a convertible soft covering system. Further, Gunn '195 only discloses a screen to keep insects out, not for

the result effective variable of blocking sunlight nor the additional air and noise reduction achieved with a second screen. The rear cover for a pick-up truck disclosed in Gunn '195 does not disclose the window system of the applicant's invention. Therefore, the addition of insertable screens would not be obvious. As a result, claims 6, 11, 12, and 15 are not obvious in view of Gunn '195.

3. Rejection of Claims 3, 7, and 16

The Examiner rejected claims 3, 7, and 16 as being unpatentable over Gunn '195. The Examiner claimed that Gunn '195 discloses the window system of applicant's claim 1 and that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to use a woven vinyl coated material since it has been held to be within the general skill of the worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious mechanical expedient." (Examiner's Office Action p. 5). Applicant respectfully disagrees with the Examiner's rejection regarding claims 3, 7, and 16.

Gunn '195 is a non-analogous prior art reference, and, as discussed above, does not disclose every element of applicant's claimed invention. Gunn '195 teaches away from applicant's invention because it teaches the use of a rigid camper and not a convertible soft covering system. The rear cover for a pick-up truck disclosed in Gunn '195 does not disclose the window system of the applicant's invention. Further, the woven vinyl coated screens of the present invention are used in the housing industry, not the automotive industry. Therefore, the material used for the screen would not have been obvious. As a result, claims 3, 7, and 16 are not obvious in view of Gunn '195.

Gunn is a camper using a screen that is used for housing to would be analogous b/c campers are mobile houses

4. Rejection of Claims 4, 5, 8, 9, and 10

The Examiner rejected claims 4, 5, 8, 9, and 10 as being unpatentable over Gunn '195 in view of Applicant's Admissions. The Examiner claimed that Gunn '195 discloses the window system of claims 1 and 6 and that applicant disclosed a material which blocks over 75% of the sun's rays. (Examiner's Office Action p. 5). Applicant respectfully disagrees with the Examiner's rejection regarding claims 4, 5, 8, 9, and 10.

Gunn '195 is a non-analogous prior art reference, and, as discussed above, does not disclose every element of applicant's claimed invention. Gunn '195 teaches away from

applicant's invention because it teaches the use of a rigid camper and not a convertible soft covering system. The rear cover for a pick-up truck disclosed in Gunn '195 does not disclose the window system of the applicant's invention. Further, the woven vinyl coated screens of the present invention are used in the housing industry, not the automotive industry. Therefore, the material used for the screen would not have been obvious. As a result, claims 4, 5, 8, 9, and 10 are not obvious over Gunn '195 in view of Applicant's Admissions.

Conclusion

Applicant believes he has addressed and responded to every point raised in the Examiner's action. For the reasons stated above, Applicant respectfully requests reconsideration of its application.

Respectfully submitted,

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